

REMARKS

Claims 1-7 and 9-11 were pending in this application. By the above amendment to the claims, claims 1, 5, 6, and 10 have been canceled without prejudice or disclaimer. Applicants preserve the right to pursue the subject matter of these claims in a continuation application. Claim 9 has been re-written in independent form and to recite that the subject is a "human." Support for this amendment can be found, for example, at paragraphs [0026] and [0029]¹ of the present specification and in original claim 6. Claims 2-4, 7, and 11 have been amended to correct claim dependency (to depend from claim 9). Claims 3 and 7 have been further amended to replace the term "bisphosphonate" with the term "pamidronate" as used in claim 9. Support for claims 2 and 11, as amended, can be found, for example, at paragraphs [0018], [0020], [0021], and [0028] of the present specification. Support for claim 3, as amended, can be found, for example, at paragraphs [0021] and [0022] of the present specification and in original claim 3. Support for claim 4, as amended, can be found, for example, at paragraphs [0024] and [0029] of the present specification. Support for claim 7, as amended, can be found, for example, at paragraphs [0018], [0020] and [0028] of the present specification. No new matter has been added as a result of these amendments.

Telephone Interviews with Examiner Kim

Applicants gratefully acknowledge the courtesy shown by Examiner Jennifer M. Kim during a telephonic interview with the inventor, Dr. Marco Pappagallo, and applicants' representatives, Irina Vainberg and Tanya Leavy, on July 26, 2010. During the interview, arguments against the outstanding obviousness rejection were presented to the Examiner for consideration and comment. The Examiner also confirmed that claim 9 directed to humans would be allowable.

¹ For Examiner's convenience all paragraph number references are to the application as published (U.S. Appl. Publ. No. 2004/0087551).

Applicants further gratefully acknowledge the courtesy shown by Examiner Jennifer M. Kim during a telephonic discussion with the undersigned on August 12, 2010, wherein the present amendments to the claims were discussed.

Allowable Subject Matter

In the Office Action, the Examiner has stated that claim 9, drawn to a specific subject population of human would be allowable. As claim 9 has been re-written in independent format and amended to recite that the subject is a "human," this claim is believed to be in condition for allowance. As claims 2-4, 7, and 11 have been amended to depend from claim 9, these claims are also believed to be in condition for allowance.

Obviousness Rejection

Claims 1-7 and 9²-11 have been rejected as obvious over U.S. Publication No. 2004/0063670 ("Fox") in view of Geusens et al., *J. Clin. Densitometry* (2001) 4(4): 389-394 ("Geusens"). To expedite prosecution, and without conceding the validity of the rejection, claims 1, 5-6 and 10 have been canceled. Accordingly, the rejection of these claims is rendered moot.

As set forth above, claim 9 has been re-written in independent format and amended to recite that the subject is a "human." As acknowledged by the Examiner at page 5 of the Office Action, claim 9 drawn to subject population of human is non-obvious and allowable over Fox, "since Fox in their illustrated example ([0105]) teach that pamidronate was weakly active in the model of neuropathic pain producing a maximal 20% reversal of hyperalgesia in a rat." Claims 2-4, 7, and 11 have been amended to depend from claim 9. Accordingly, Applicants respectfully submit that the rejections of claims 2-4, 7, 9, and 11 over the prior art have been obviated and should be withdrawn.

² Claim 9 directed to the subject population of "mammal" was included in the obviousness rejection.

Conclusion

Applicants request entry of the foregoing amendments and remarks in the file history of this application. In view of the above amendments and remarks, it is respectfully submitted that pending claims are in condition for allowance and such action is earnestly solicited. If the Examiner believes that a telephone conversation would help advance the prosecution in this case, the Examiner is respectfully requested to call the undersigned attorney at (212) 641-2364. The Commissioner is hereby authorized to charge the required fee(s) and/or credit the refund(s) due to Deposit Account No. 06-1050.

Respectfully submitted,

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